

### **REMARKS**

Applicants acknowledge receipt of the Office Action dated July 12, 2006 wherein:

(1) claims 1-12, 18-42, 45-62, 70-81, 84-96, and 98-100 were rejected under 35 U.S.C. § 102(b);

(2) claims 13-17, 43, 44, and 97 were rejected under 35 U.S.C. § 103(a); and (3) claims 63-69, 82, and 83 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim.

#### ***Status of the Claims***

Claims 4-6, 8, 10-12, 14-34, 43-69, 72-85, and 87-94 are in original form.

Claims 1, 3, 7, 9, 13, 38, 41-42, 71, and 86 are currently amended.

Claims 2, 35-37, 39-40, 70, and 95-100 have been canceled.

#### ***Allowable Subject Matter***

Applicants note with appreciation that claims 63-69, 82, and 83 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Rejections under 35 USC § 102(b)***

Claims 1-12, 18-42, 45-62, 70-81, 84-96, and 98-100 were rejected under 35 U.S.C. § 102(b). As explained by the Court of Appeals for the Federal Circuit: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended claim 1 reads:

1. (Currently Amended) A disposable downhole tool or a component thereof comprising an effective amount of biodegradable material such that the tool or the component desirably decomposes when exposed to a well bore environment; wherein the tool comprises a frac plug, a bridge plug, or a packer and wherein the biodegradable material comprises a degradable polymer.

Amended claims 3, 7, 9, and 13 are subject to similar limitations.

Amended claim 38 reads:

38. (Currently Amended) A method for performing a downhole operation wherein a disposable downhole tool is installed within a well bore comprising: desirably decomposing the tool or a component thereof *in situ* via exposure to the well bore environment; wherein the tool comprises a frac plug, a bridge plug, or a packer fabricated from a biodegradable material and wherein the biodegradable material comprises a degradable polymer.

Amended claims 71 and 86 are subject to similar limitations.

Support for the amending language can be found in the specification. *See, e.g.*, Application ¶¶ [0007] (“The present invention relates to a disposable downhole tool or component thereof comprising an effective amount of biodegradable material such that the tool or the component desirably decomposes when exposed to a wellbore environment. In an embodiment, the biodegradable material comprises a degradable polymer”); and [0048] (“In particular, the type of biodegradable downhole tool 100, or the particular components that make up the downhole tool 100 could be varied. For example, instead of a frac plug 200, the biodegradable tool 100 could comprise a bridge plug . . . [or] a packer . . .”).

***Rejections under 35 USC § 102(b) in view of Grigsby***

Claims 1-12, 18-22, 24, 32-34, 38-42, 46-62, 71, 85, 86, and 88-93 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent Application Pub. No. US2005/0056425A1 to Grigsby et al. (hereinafter *Grigsby*). Claims 2, 35, 36, 37, 39, 40, 70, and 95-100 have been

canceled. The Office Action did not reject claims 35, 36, 37, 70, and 95-100 as being anticipated by *Grigsby*. Applicants have taken the elements of claims 2, 35, 36, 37, and 70 and included those elements in amended independent claims 1, 38, 71, and 86. Thus, the pending amended independent claims contain an element, or elements, not present in *Grigsby*. Accordingly, the pending claims should be allowed as they are not anticipated by *Grigsby*. Additionally, because claims 3-12, 18-22, 24, and 32-34 depend on amended claim 1; claims 39-42 and 46-62 depend on amended independent claim 38; claim 85 depends on amended independent claim 71; and claims 88-93 depend on amended claim 86; dependant claims 3-12, 18-22, 24, 32-34, 39-42, 46-62, 85, and 88-93 should be allowed because they are not anticipated by *Grigsby*.

***Rejections under 35 USC § 102(b) in view of Owens***

Claims 1, 23, 25-31, 35-38, 45, 46, 51, 53-62, 70-81, 84, 86, 87, 89, 93-96, and 98-100 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 5,607,017 to Owens et al. (hereinafter *Owens*). As previously noted, claims 2, 35, 36, 37, 39, 40, 70, and 95-100 have been canceled. The Office Action did not reject claims 39, 40 and 97 as being anticipated by *Owens*. Applicants have taken the elements of claims 39, 40 and 97 and included those elements in amended independent claims 1, 38, 71, and 86. Thus, the pending amended independent claims contain an element, or elements, not present in *Owens*. Accordingly, the pending claims should be allowed as they are not anticipated by *Owens*. Additionally, because claims 23 and 25-31 depend on amended claim 1; claims 45, 46, 51, and 53-62 depend on amended independent claim 38; claims 72-81, and 84 depend on amended independent claim 71; and claims 87, 89, and 93-94 depend on amended claim 86; dependant claims 23, 25-31, 45, 46, 51, 53-62, 72-81, 84, 87, 89, 93, and 94 should be allowed because they are not anticipated by *Owens*.

**Rejections under 35 USC § 103(a)**

Claims 13-17, 43, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Grigsby* in view of Munoz, Jr. et al. U.S. Patent No. 7,036,587 (hereinafter *Munoz*). Thus, claims 13-17, 43, and 44 stand or fall on the application of *Grigsby* to the claims. The requirements for establishing a *prima facie* case of obviousness are well established:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As explained in reference to the § 102(b) rejections above, *Grigsby* fails to teach or suggest the limitations contained in amended claims 1, 38, 71, and 86. In addition, all dependent claims incorporate the limitations of the claims they depend on. Because claims 13-17, 43, and 44 depend on and; therefore, incorporate the limitations of amended claims 1 and 38, and *Grigsby* fails to teach the limitations of amended claims 1 and 38, *Grigsby* also fails to teach or suggest the limitations contained in claims 13-17, 43, and 44. The Office Action does not cite *Munoz*, or other prior art references, to teach the limitations that are absent from *Grigsby*. Thus, the Office Action does not establish a *prima facie* case of obviousness as to claims 13-17, 43, and 44, which are allowable over the cited prior art.

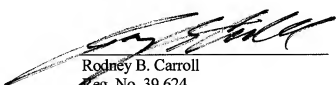
CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated July 12, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,  
CONLEY ROSE, P.C.

Date: 10-11-06



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